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APPLICANT(S): Timothy M. Wiles et al.

SERIAL NO.: 09/583,891

GROUP: 1627

FILING DATE: May 31, 2000

EXAMINER: R. Gitomer

FOR: System and Method for Analyzing Antibiotic Susceptibility of Biological Samples

Assistant Commissioner of Patents  
Washington, D.C. 20231

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Donna M. Baumann

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RESPONSE PURSUANT TO 37 CFR §1.143

Sir:

In response to the Official Action of May 17, 2002, setting forth a requirement for restriction, Applicants provisionally elect, with traverse, the subject matter of Group I, Claims 1-10, drawn to a method for analyzing a sample, classified in Class 435, Subclass 4.

REMARKS

Claims 1-28 are present in this application. These claims have been subjected to restriction by the Examiner under 35 USC §1.121 as follows:

Group I, directed to Claims 1-10, drawn to a method for analyzing a sample, classified in Class 435, Subclass 4;

Group II, directed to Claims 11-20 and 25-28, drawn to a computer readable method, classified in Class 711, Subclass various ; and

Group III, directed to Claims 21-24, drawn to a method for determining MIC (minimum inhibitory concentration), classified in Class 435, Subclass 32 .

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-10, and reserve the right to file a divisional application directed to the non-elected subject matter of the remaining claims in this application.

However, Applicants respectfully traverse the present restriction requirement and request reconsideration of this restriction requirement in view of the following remarks.

It was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which is attached herein. In the present case, all of the claims of the present invention share common subject matter related to the analysis of a sample to determine the susceptibility of the sample to antimicrobial materials such as by utilization of a computer-readable medium of instructions or by the methods set forth in Claims 1 (which method provides at least two growth indicator values, each representing a respective growth characteristic of the sample) and 21 (which method provides for determining at least one MIC value for a sample). This can be found in the independent Claims 1, 11 and 21 and all claims dependent thereon.

In view of this, Applicants respectfully submit that all of Claims 1-28 share common subject matter, and thus Applicants respectfully request that the present restriction requirement be withdrawn.

Applicants further respectfully submit that, at the very least, Groups I and III should be examined together, since they are both classified in Class 435, and all the claims in Groups I and III are directed to method claims related to the analysis of a sample contained in at least one well.

It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to

make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. In re Kuehl, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

Thus, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



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